

Amendment
Serial No. 10/082,839

Docket No. US028013

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JUL 05 2006**REMARKS**

The Office Action dated April 5, 2206 has been reviewed and carefully considered. Claims 1-20 remain pending, the independent claims remaining 1, 14 and 18. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 1, 14 and 18 stand objected to for use of the phrases "capable of" and "capability of."

Claim 1 recites, "... the OFDM station learns of the modulation capability.

."

Claim 14 recites, "... means for learning of the modulation capability. . ."

Claim 18 recites, "... the access point learns of the modulation capability. .

."

In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention. MPEP 2111.04.

MPEP 2111.04 states, "Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure."

At least since a claim is properly interpreted as a whole, the immediately-above-stated conditions do not apply to claims 1, 14 or 18.

The instant applicants respectfully submit that each of the phrases "capable of" and "capability of" in claims 1, 14 and 18 carries patentable weight, and "cannot be ignored."

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Reconsideration and withdrawal of the objection is respectfully requested.

Claims 1-20 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,940,827 to Li et al. ("Li") in view of U.S. Patent No. 6,990,116 to Young et al. ("Young").

Claim 1 recites, "... the OFDM station learns of the modulation capability of the intended receiving station and transmits OFDM modulated data if the receiving station is capable of OFDM modulation and transmits DSSS/CCK modulated data if the receiving station cannot decode OFDM modulation."

Li, at best, discloses or suggests merely that an OFDM station learns whether another station desires (col. 11, line 67: "desires") to use a particular modulation rate.

Young relates to LANs, but cannot make up for the shortcomings of Li.

The Office Action erroneously cites to the same Li passage quoted immediately above, but seemingly does not take notice of the use of the word "desires."

For at least the above reason, the cited references alone, or in combination, fail to anticipate or render obvious the present invention as recited in claim 1.

Claim 14 recites, "... means for learning of the modulation capability of a receiving station, the learning means being operably coupled to the first and second transmission means; wherein the first communication arrangement transmits OFDM modulated data if the receiving station is capable of OFDM modulation and the second communication arrangement transmits DSSS/CCK modulated data if the receiving station cannot decode OFDM modulated data."

The discussion above with regard to claim 1 likewise applies to claim 14.

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Claim 18 recites, "... the access point learns of the modulation capability of the station and transmits OFDM modulated data to the station if the station is capable of OFDM modulation and transmits DSSS/CCK modulated data to the station if the station cannot decode OFDM modulated data."

The discussion above with regard to claim 1 likewise applies to claim 18.

Each of the other rejected claims depends from a base claim that has been shown to be patentable over the prior art of record and is likewise deemed to be patentable at least due to its dependency.

However, each warrants separate consideration based on its individual, further merits.

For example, claim 2 recites, "... the OFDM station learns of the modulation capability of the receiving station when the OFDM station joins the network."

Claim 4 recites, "... the OFDM station learns of the respective modulation capabilities of all other stations present in the network when the OFDM station joins the network."

The Office Action erroneously cites in Li to column 10, lines 53-60 and to column 11, lines 38-40 and 64-66.

However, firstly, Li merely discloses that a base station is reported to. Li does not disclose that a base station receives the reports "... when the OFDM station joins the network." The passages the Office Action cites do not indicate or suggest whether the reporting of information occurs periodically, whether it is event-driven, etc.

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Secondly, Li fails to disclose or suggest learning of "the modulation capability." Li merely discloses feedback information indicating a rate pertaining to a desired modulation scheme.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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